

REMARKS

The Final Rejection mailed March 12, 2004, has been carefully studied, but is strongly and respectfully traversed. The claims in the application remain as claims 6-10; these claims define patentable subject matter under Sections 102, 103 and 112, and therefore should be allowed. Accordingly, applicant hereby respectfully requests favorable reconsideration, entry of the amendments submitted above, and formal allowance.

Claim 8 has been objected to because of a typographical error which the examiner has helpfully pointed out. This typographical error is now proposed to be corrected by the amendment presented above to claim 8.

Claims 6-10 have been rejected under the first paragraph of Section 112. This rejection is strongly and respectfully traversed.

Applicant respectfully takes the very strongest issue with this rejection. To say that conventional glass "such as quartz glass or boro-silicate glass, or an inorganic substrate such as a silicon wafer" and that a polyester film

and a polyethylene film are not inherently non-porous makes no sense at all. Of course such materials are non-porous; this is both inherent and implicit. When someone refers to these materials without qualifying their nature by saying explicitly that they are "porous", then anyone skilled in the art (indeed anyone in the common public) would know that these materials are non-porous. An applicant need not state explicitly what is clearly implicit.¹

Moreover, in the context of the description of applicant's invention, the substrate must be non-porous. Otherwise, the through-holes filled with porous material makes no sense. Consider for example applicant's specification in the paragraph at lines 3-8 of page 3:

Based on these studies, the inventors found that the above-described problems could be solved by filling and holding carriers into a plurality of through-holes regularly arranged in a substrate, the carriers having different probe molecules fixed for the respective holes, and then introducing a sample into the carrier-filled holes.

If the substrate were porous, there would be no difference between the substrate and the porous material (the carrier) filled within the through-holes of the substrate, and the

¹ Nevertheless, so that there will be no question, applicant proposes to amend the specification by amendment presented above.

sample would permeate through the substrate and not be retained in the carrier within the through-holes.

The law is clear that an applicant may explicitly state, without the introduction of prohibited "new matter", that which is implicit or inherent from the applicant's original disclosure. Therefore, the rejection under the first paragraph of Section 112 is absolutely incorrect, is unjustified, and should be withdrawn.

Nevertheless, to achieve what is basically and fundamentally the same concept in applicant's claims, while avoiding the criticized language, applicant proposes above to amend claim 6 to delete the terminology objected to and add equivalent language which specifies that the carrier is relatively porous compared with the substrate. Applicant considers this amendment to be cosmetic involving no change in scope of applicant's claims. No limitations have been added in this regard and none are intended.

Applicant respectfully requests withdrawal of the rejection.

Claims 6 and 10 have been rejected under Section 102 as anticipated by Beattie. This rejection is respectfully traversed.

Claim 6 is proposed to be amended above to call for a plurality of stacked substrates as clearly shown in Fig. 5, clear support being provided in applicant's specification at page 11, lines 27-32, for example, as well as in the sentence spanning pages 12 and 13. No analogous or similar subject matter is shown in Beattie.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 7-9 have been rejected as obvious under Section 103 from Beattie in view of Düsterhöft, the latter having been previously applied under Section 102. This rejection is respectfully traversed.

Düsterhöft has not been cited to make up for the aforementioned deficiencies of Beattie, and indeed does not do so. Therefore, even if the combination were obvious as proposed (not conceded by applicant), the combination would not reach applicant's claims as claims 7-9 which incorporate the subject matter of claim 6.

Withdrawal of the rejection is in order and is respectfully requested.


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Applicant believes that all issues have been addressed and resolved above. Applicant accordingly respectfully requests favorable reconsideration, entry of the amendment presented above and allowance.

Respectfully submitted,

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